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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,154	07/15/2003	David J. Talaber	R0372-00101	8486
7590 EDWARD J LYNCH PATENT ATTORNEY One Embarcadero Center Suite 562 San Francisco, CA 94111			EXAMINER RAMANA, ANURADHA	
			ART UNIT 3775	PAPER NUMBER
			MAIL DATE 12/07/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/620,154

**Applicant(s)**

TALABER ET AL.

**Examiner**

Anu Ramana

**Art Unit**

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31, 33-40, 42-60, 63-79, 84-86, 88-96, 98-102 and 104-119 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-28, 52-59, 84-86, 88 and 107-113 is/are allowed.
- 6) ☒ Claim(s) 1-20, 29-31, 33-51, 60, 63-79, 89-96, 98-102, 104-106 and 114-119 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 117 is objected to because of the following informalities.

In claim 117, line 3, "is" should be "in" to correct a minor typographical error.

In claim 117, it is suggested that transverse dimension in the first configuration be qualified using "first" and the transverse dimension in the second configuration be qualified using "second" to avoid confusion.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20, 51, 74-79, and 89-93 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, the recitation "so that the head is retained by the posterior stopping surface of the stopping member" seeks to introduce new matter. The word "by" seems to imply that the posterior stopping surface of the stopping member is retaining the head of the securing element. The stopping surface only prevents screw back-out.

Similar comments apply to claim 89.

It is noted that Applicant's disclosure, as originally filed, shows the head to be retained between the posterior stopping surface of the biased stopping member and the second opening in the stabilizing element or the posterior bore portion of the attachment member.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20, 29-31, 33-40, 42-51, 60, 63-79, 89-102, 104-106 and 114-119 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation "by the posterior stopping surface of the stopping member within the transverse passageway between the biased stopping member and the second opening in the stabilizing element" renders the claim vague and indefinite since this amounts to double inclusion. Similarly, in claim 29, the recitation "by the posterior stopping surface of the stopping member" renders the claim vague and indefinite since this amounts to double inclusion.

Similarly, in claim 63, the recitation "by the posterior stopping surface of the stopping member" renders the claim vague and indefinite since this amounts to double inclusion.

Similarly in claim 89, the recitation "by the posterior stopping surface" renders the claim vague and indefinite since this amounts to double inclusion.

Similarly in claim 96, the recitation "by the stopping surface" renders the claim vague and indefinite since this amounts to double inclusion.

The head in the device of applicant's invention is retained in the transverse passageway or posterior bore portion between the posterior surface of the stopping member and the second opening.

In claim 115, the recitation "and which defines at least in part a length..." renders the claim vague and indefinite since it is unclear what structure is being referred to by "which defines". It is suggested that the recitation be modified, for e.g., "the posterior bore portion being longer than the length of the enlarged integral portion of the securing member to allow displacement of the enlarged integral portion of the securing member within the posterior bore portion."

In claim 118, "the second transverse dimension" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 89-95, 115 and 116 are rejected under 35 U.S.C. 102(b) as being anticipated by Dill (US 5,118,235).

Dill discloses a stabilizing element 10 having an anterior surface, a posterior surface and at least one bore 56 having an anterior bore portion and a posterior bore portion, the posterior bore portion having a transverse dimension smaller than a transverse dimension of the anterior bore portion; a resilient radially deflectable member or biased collar 90; and a screw or "securing element" 12 having an elongated body 30 with a head 24 integral with the body, the head having a maximum transverse dimension greater than a transverse dimension of the posterior opening of the posterior bore portion (Figs. 1, 3-4 and 7, col. 3. lines 58-68, col. 4 and col. 5, lines 1-64).

Regarding claim 92, the first configuration or expanded or unrestrained configuration of the collar is the position shown in Fig. 3.

Regarding claim 115, the first configuration of the biased collar 90 is the position shown in Fig. 3 (col. 4, lines 43-47) and the second configuration is the position shown in Figs. 4 and 7 (col. 4, lines 48-59).

Regarding the recitation, "An orthopedic implant assembly" it is noted that if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of

the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation") ( per MPEP 2111.02).

Claims 89-95 are rejected under 35 U.S.C. 102(e) as being anticipated by Campbell et al. (US 6,258,089).

Campbell et al. disclose an orthopedic implant assembly including: a plate or stabilizing element 106, the stabilizing element having a bore 120a with a posterior bore portion having a posterior opening with a transverse dimension smaller than a transverse dimension of the anterior bore portion; a securing element 132 having an elongated body and an enlarged integral portion 138, portion 138 having a transverse dimension greater than a transverse dimension of the posterior opening; a resilient radially deflectable member 112 that allows the securing element 132 to pass into the posterior bore portion in a first or expanded configuration (Fig. 23) and a second configuration in which the enlarged integral portion of the securing element is retained in the posterior bore portion (Figs. 23-26, and col. 7, lines 27-65).

### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on May 27, 2008 have been fully considered.

Applicant's amendments to claims 52 and 54 overcome the rejections under 35 USC 112 second paragraph.

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

It is noted that upon further consideration, claims 89-95, and 115-116 have been rejected under 35 USC 102(b) over Dill. As discussed in this office action, Dill discloses all elements of Applicant's claimed invention, thereby anticipating the claimed invention.

The preamble "orthopedic implant assembly" or "orthopedic attachment assembly" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

#### ***Allowable Subject Matter***

Claims 29-31, 33-40, 42-50, 60, 63-73, 96, 98-102, 104-106, and 114 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 21-28, 52-59, 84-86, 88 and 107-113 are allowed.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached at (571) 272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
December 6, 2009

/Anu Ramana/  
Primary Examiner, Art Unit 3775